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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/223,564	09/01/2011	Nir Berzak	1800.0009	7639

75485 7590 02/03/2017
The Law Office of Michael E. Kondoudis
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EXAMINER

FWLER, DANIEL WAYNE

ART UNIT	PAPER NUMBER
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3739

NOTIFICATION DATE	DELIVERY MODE
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02/03/2017

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NIR BERZAK, SIMON SHARON,
and RON HILLELI

Appeal 2015-003775
Application 13/223,564
Technology Center 3700

Before JOHN C. KERINS, JAMES P. CALVE, and
SCOTT A. DANIELS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Nir Berzak et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 15, 17, and 18. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellants' claimed invention is directed to a cryosurgical instrument. Claim 1, reproduced below, is illustrative:

1. A cryosurgical instrument that is selectively positioned in a patient by rotation, comprising:

a manipulation section that permits a user to rotate the instrument;

a cryogen supply portion; and

a positioning section having a sharp tip at an end thereof and a helical configuration, the positioning section configured to receive cryogen from the cryogen supply portion and to permit the received cryogen to cool the positioning section.

THE REJECTION

The Examiner rejects claims 1, 2, 15, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Ryan (US 6,280,441 B1, issued Aug. 28, 2001) in view of Dalbec (US 7,200,445 B1, issued Apr. 3, 2007) and Duong (US 2005/0043725 A1, published Feb. 24, 2005).

ANALYSIS

Appellants present arguments directed to the rejection of all claims as a group, and do not present separate arguments for any claim individually. Appeal Br. 8–16. We therefore take claim 1 as representative of the group of claims, and claims 2, 15, 17, and 18 stand or fall with claim 1.

The Examiner finds that Ryan discloses an ablation instrument meeting most of the elements in claim 1, including a positioning section having a sharp tip and a helical configuration, but does not disclose a cryogen supply portion and that the positioning section is configured to receive cryogen from the supply portion. Final Act. 3. The Examiner further cites to Dalbec as an exemplary reference that discloses the

equivalence of several energy types for the purpose of ablating tissue, and to Duong as disclosing structure enabling the inflow and outflow of a cryogen in a cryosurgical device. *Id.* The Examiner concludes that it would have been obvious to modify the Ryan ablation device to be a cryoablation device. *Id.*

Appellants argue that the Examiner's proposed modification brings about a change in the principle of operation of the Ryan device, and, as such, under prevailing precedent, the proposed modification is impermissible and the references do not render claim 1 *prima facie* obvious. Appeal Br. 8–16; Reply Br. 2–3. Appellants assert that the principle of operation in Ryan is the use of radio frequency (RF) energy to ablate or kill cells. *See, e.g.*, Reply Br. 2. Thus, according to Appellants, the proposed modification to Ryan such that it would employ a cryogen to ablate or kill cells, amounts to a change in the principle of Ryan, which renders the proposed modification impermissible. *Id.*

The Examiner's position is that the principle of operation of Ryan is an application of energy to tissue. Ans. 3. The application of energy is intended to result in death of cells exposed to the energy. *Id.* The Examiner regards Ryan's use of RF energy as a manner or mode by which energy is applied to tissue, and that a modification to Ryan such that it operates to apply energy in the form of a cryogen is not a change in the principle of operation. *Id.* at 3–4.

The Examiner has the better position here. Appellants principally point to MPEP Section 2143.01(VI) in support of their argument that the proposed modification is in violation of existing precedent. Appeal Br. 10.

That section cites to *In re Ratti*¹ as standing for the principle that a rejection is improper if it results in a change in the basic principle of operation under which a principal reference is designed to operate. More recently, however, our reviewing court found that a change in the type of circuitry, from optical to electrical, employed to operate a programmable arithmetic processor did not change the basic principle of receiving inputs into a programmable crossbar array and processing the output to obtain an arithmetic result. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). The Court there found that the evidence supported the Examiner’s finding that there was nothing in the processing and programming of junction states that was unique to an optical implementation, and thus employing an electrical implementation did not amount to a change in the basic principle of operation of the device in the principal reference. *Id.*

In the present case, Appellants acknowledge that both RF energy and cryogenics “can certainly achieve the same result/objective (ablation) and even exhibit the same efficacy.” Reply Br. 3. Thus, like the circumstances in *Mouttet*, there appears to be nothing unique to a cryogenic implementation as claimed as compared to an RF implementation in Ryan. Indeed, just as Appellants did not discover cryosurgical ablation of cells, Ryan did not discover the use of RF energy to ablate or kill cells. Spec. 1; Ryan, col. 1, l. 10–col. 2, l. 19.

The Ryan device was designed to operate to provide a probe that employs a single entry site, yet is also of an efficient geometric shape to affect large areas for ablation without undue trauma in getting the device in

¹ 270 F.2d 810 (CCPA 1959).

place, and is further able to provide a significant depth of penetration into the tissue to effect lesioning or ablation of cells subcutaneously at appreciable depths. Ryan, col. 2, ll. 20–45; col. 3, ll. 26–31. The efficient geometric shape disclosed in Ryan for the probe or effector is a helical shape that, in addition to the above aspects, facilitates accurate trajectory of the device and accurate depth location. *Id.*; Fig. 1.

The Examiner’s proposed modification of the Ryan device does not affect the ability of the device to ablate tissue, nor does it alter the geometry or shape of the probe or effector that results in accurate placement of the probe within a body while avoiding undue trauma, as well as its ability to ablate large areas at significant depths. As such, the modification does not change the basic principle of operation of Ryan, and the rejection is therefore not improper.

Accordingly, we sustain the rejection of claim 1 as being unpatentable over Ryan, Dalbec, and Duong. Claims 2, 15, 17, and 18 fall with claim 1. Because the analysis above extends beyond that employed by the Examiner, the affirmance of the rejection is designated as a new ground of rejection under 37 C.F.R. § 41.50(b), in order to provide Appellants with a fair opportunity to respond to the additional rationale.

DECISION

The rejection of claims 1, 2, 15, 17, and 18 under 35 U.S.C. § 103(a) is affirmed. The affirmance is designated as a new ground of rejection under 37 C.F.R. § 41.50(b).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant

to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED